



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------------|------------------|
| 09/784,224 | 02/15/2001 | J. David Martin | BHAM-01001US0 SRM/KFK | 2546 |
| 23910 | 7590 | 09/01/2006 | EXAMINER RUHL, DENNIS WILLIAM | |
| FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111 | | | ART UNIT 3629 | |

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/784,224 | Applicant(s) MARTIN, J. DAVID | |
| | Examiner Dennis Ruhl | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14,16-20,22,23 and 25-34 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-14,16-20,22,23,25-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3629

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/06 has been entered.

2. The amendment filed 6/19/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Please see the 112, 1st rejection where the new matter limitations are discussed.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10-14, 16-20, 23, 25-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has reviewed the originally filed specification and cannot find any discussion as to there being separate communication links for each vendor. Where was this disclosed in the application as originally filed? The only discussion appears to be that a web page on the Internet is used. Where does support come from for the newly added limitation? Also considered to be new matter is the recitation that the data received from the vendors is updated as received in real time. Where was it disclosed in the specification as originally filed that the data from the vendors is received and updated in real time? The examiner cannot find this in the specification as originally filed.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10-14,16-20,22,23,26,27,31-34, are rejected under 35 U.S.C. 102(b) as being anticipated by Fino et al. (5689705).

For claims 10,11, Fino discloses a system as claimed. Fino discloses a system and method for allowing a potential purchaser of a home (anybody) to review building designs and create a customized home by choosing from various building options/services. The database processor is the server 25 and is disclosed as updating the database (addressed below) as claimed. The user interface is the software/programming that creates the various screens shown in the figures. The

interface allows for design data to be presented to the user as claimed and is capable of taking inputted selections from the user as claimed. The prior art has this capability.

The communication links are the networking of computers between regional offices, sales offices, corporate offices, and design centers that allows transfer of any kind of data (sales, buyer data, homes data, etc.). This allows data to be sent between more than one other entity (not just between two computers) and this satisfies what has been claimed with respect to the communication links. See column 7, lines 5-55. Each computer has a modem and software that allows data communication to occur. This is considered to be the claimed "separate" communication links. The central server is the computer of any one of the offices that are networked together. The recitation of what kind of data the database is storing is considered to be non-functional descriptive material that does not serve as a limitation (*In re Gulack*, 217 USPQ 401 (CAFC 1983)), but the claimed data is satisfied by the fact that design options for homes are available for review by a user of a system. With respect to the recitation to "data specifying a plurality of agreements", an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system but is taken as another recitation to non-functional descriptive material. Describing the data that a system stores in apparatus claims is not going to define over the prior art when that is the only difference between the claim and the prior art. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. The prior art is fully capable of what has been claimed.

For claim 12, the examiner considers the server of Fino to be a Web server. A server is a server and the term "Web" lends no further structure to the term "server". Fino discloses various screens for the display of data. Screens are pages as claimed. The examiner does not consider the name of the page to be reciting any specific type of structure, because the claimed page is not even a structural element of the system but rather is an intangible thing (a collection of data to be displayed).

For claims 13,14, for the system to be able to transfer data to and from the various offices discussed in column 7, some kind of data transfer protocol is required. The term "Internet transfer protocol" is considered satisfied by Fino. The Internet is simply a bunch of connected computers and this is what Fino discloses. This is also a recitation directed to the type programming language used for the transfer of data, which is not a structural limitation, but rather is an intangible thing.

For claim 20 this claim is directed to the method of use for the system where Fino is fully capable of operating as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case the prior art is fully capable of preparing an order that will be

sent as claimed. No further structure to the system is recited in this claim, only a method step.

For claims 16-18, applicant is reciting what kind of vendors there are. The examiner reminds applicant that the instant claims are apparatus claims and that the vendors are not part of the system itself. When applicant recites that the vendors are manufactured building manufacturers or that they are separate lot developers, this is not reciting anything further to the system from that claimed in claim 10. The vendors are not a structural part of the system and these claims are not taken as reciting any further structure to the system. The prior art satisfies what is claimed.

For claim 19, the order processor is the Contract Module of Fino and operates as claimed.

For claim 22, the claimed finance processor is considered to be the Finance Module of Fino.

For claim 23, Fino discloses a method as claimed. Fino discloses a system as claimed. Fino discloses a central server 25. The server stores data of building design elements as claimed. The providing of a plurality of communication links to vendors is considered inherent because vendors that are in the business of home building have telephone numbers for their business. This is so that potential customers can reach them if needed to discuss business. The plurality of communication links are the phone numbers of each vendor. The term "communication link" includes individual phone numbers, which are communication links. The communication links allow for information to be obtained as claimed. A user can select from options (features) as

Art Unit: 3629

claimed by using the Options Module. The inputs are made via a user interface (computer). A home manufacturer is inherently selected as claimed because you are reviewing home models of a manufacturer. With respect to the selecting of a contractor to prepare a site for placement of the home, this is inherently done. A contractor must be selected to make the foundation for the home at some point in the process so that the home can then be built. The ordering of parts and labor to construct the home is also inherently part of the process. With respect to the recitation to storing "data specifying a plurality of agreements", this is taken as non-functional descriptive material. The data specifying the agreements is not used in any manner or in any kind of step in the claims, so this limitation is just descriptive of the kind of data being stored. Unless the data is used in some manipulative manner, it is considered to be non-functional descriptive material. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. Method step wise, the prior art is fully capable of what has been claimed because a vendor can provide design elements are claimed. In Fino, it is inherent that data is updated as claimed. This is inherent because new data at the central server is sent to each and every other computer in the network so that each computer has the updated and most recent data.

For claim 26, Fino discloses the claimed method. With respect to the recited providing of a system, Fino discloses a system as claimed as set forth already by the examiner for claim 23. Fino discloses that building layouts and available features are

saved and selectable by a potential home purchaser. This is the done in the Options Module and the Plan Selection Module of Fino. The database must be updated as claimed so that the features and plan layouts can be stored. The user then selects the layout they desire and any options they desire. The chosen options are preferred options. With respect to the apparent structural recitation to “agreements”, an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system, which is the way it has been claimed. Applicant has claimed an agreement and the examiner notes that this is not a method step of creating any kind of agreement with vendors but is claimed as part of the system. The claim is not reciting that there are agreements stored (which is just data anyway) but appear to be reciting the agreements as a structural part of the system, which they are not because they are not a tangible thing that could constitute structure to a system. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. Method step wise, the prior art is fully capable of what has been claimed because a vendor can provide design elements are claimed.

For claim 27, see figures 2A-2E, which show the displaying of a drafted design.

For claim 31-33, it is disclosed that the Contract Module can print a contract. A contract is an order to construct the building. The order is then sent to a vendor (the builder).

For claim 34, see column 6, lines 15-24 where the claimed limitation is disclosed.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 25,28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fino et al. (5689705) in view of Barad et al. (6206750). Fino discloses the invention substantially as claimed.

For claims 25,28-30, Fino does not disclose that the step of receiving inputs is done by the use of a Web site and a HTTP server. Fino discloses the use of a computer/server that may be networked to other offices and their computers for the selection of home designs and options. Fino does not disclose that the reviewing of home layouts and selection of features/options is done by a Web site as claimed. Barad discloses a method for ordering of customized toys via the Internet and a Web page. Users can log onto the web site, choose a toy and customize the toy by choosing from available features/options. Barad teaches the ordering of a custom article that was customized by the user via the Internet. Barad also discloses in the figures the well-known Hypertext Transfer Protocol, which is the standard for Internet use. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fino by providing a Web page for the selection and customization of the homes that are available for purchase. The use of HTTP necessarily follows with the modification of Fino. Barad discloses the use of the Internet and a Web page for the

purchasing of an article that can be customized, and one of ordinary skill in the art would have been motivated to provide Fino with this feature. This would allow a potential customer to review and select home layouts and available options, from anywhere, and would not require them to actually visit a sales office. This would then allow the method of Fino to be available to anyone that has Internet access and results in a much more user-friendly format.

9. Applicant's arguments filed 6/14/06 have been fully considered but they are not persuasive. Applicant has argued that the prior art does not disclose a plurality of communication links to a plurality of vendors as claimed. This limitation is considered to be new matter as set forth in the rejection of record. With respect to the prior art, this limitation has been addressed in the rejection of record. The argument is found to be non-persuasive because as interpreted by the examiner, the prior art has structure that satisfies what is claimed. With respect to the argument that the prior art is not storing data specifying a plurality of agreements, this is non-functional descriptive material and has also been addressed in the rejection of record. Applicant is more or less arguing that the storing of a particular kind of data renders the claims novel. The examiner disagrees. For claims 11-22,24,27,31-43, applicant has summarized what is claimed but no argument has been presented as far as why the prior art rejection does not satisfy what has been claimed. These summaries are taken as nothing more than a mere allegation of patentability. The same is true for claims 25,28-30, where applicant

has not traversed the obviousness statement of the 103 rejection, but has just presented a summary of the claimed subject matter.

The arguments are found to be non-persuasive.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER